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C. **REMARKS**

1. **Summary**

Claims 1-27 are currently pending in the application. Claims 1, 11, 19, and 27 are independent claims. Claims 1, 9, 7, 11, 19, and 27 have been amended. Claims 6, 14, and 22 have been cancelled. No claims or new matter has been added. Reconsideration of the claims is respectfully requested.

2. **Examiner Interview**

Applicants note with appreciation the telephonic interview conducted between Applicants' patent agent, Scott Schmok, and the Examiner on April 26, 2004. During the telephonic interview, the Examiner and Applicants' patent agent discussed the 102 reference (Scheidt, et al., U.S. Patent No. 6,490,680). In particular, Applicants' patent agent highlighted the differences between the Scheidt reference and limitations included in Applicants' original claims 1 and 6, which were rejected using the Scheidt reference. Applicants' patent agent emphasized that Applicants claim 1) establishing a secure network, 2) sending a password over a secure connection, 3) encrypting data using the password, and 4) transmitting the encrypted data over a nonsecure network. Applicants' Patent Agent continued to discuss that, in contrast, Scheidt teaches 1) establishing a secure network, 2) sending a password over a secure connection, 3) encrypting "split keys" using the password, 4) sending the encrypted split keys over a nonsecure network, and 5) encrypting and deciphering data using the split keys. The Examiner stated that he views

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the "split keys" as data, which reads upon Applicants' claim 1. Applicants' Patent Agent reminded the Examiner that if the Examiner views Scheidt's "split keys" as Applicants' claimed "data" element, the Examiner must continue to use this view throughout the patentability judgment of each of the Applicants' claims when the Applicants claim the "data" element, and "*may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation*" (MPEP 2106).

The Applicants' patent agent went on to discuss the limitations included in Applicants' claim 6, which the Office Action rejects under the assertion of inherency in view of Scheidt. Applicants' patent agent stated that under the principles of inherency, a claim is anticipated if a structure in the prior art <u>necessarily</u> functions in accordance with the limitations of a process or method claim. Mere possibilities or probabilities, however, are not enough to establish inherency. Applicants' patent agent emphasized that the limitations included in Applicants' claim 6 further limit claim 1 by, prior to establishing a secure connection, a first computer sends a request to a second computer, whereby the second computer responds and informs the first computer as to whether it accepts <u>encrypted data</u>. The Examiner stated that he originally viewed the limitations of claim 6 to correspond to an acknowledgement from the second computer that it is able to establish a secure connection. Applicants' patent agent articulated that the limitations included in claim 6 <u>do not</u> claim "*responding to the second computer's ability to establish a <u>secure connection</u>,*" rather the limitations claim "*informing the first computer that the second*

computer accepts encrypted data". In addition, using the Office Action's view of using Scheidt's "split keys" in place of Applicants' claimed "data" element as described above, Applicants' patent agent disagreed with the Office Action's assertion that it is inherent for Scheidt to send a request to a second computer system prior to establishing a secure network to determine whether the second computer system accepts encrypted split keys. The Examiner said that he would take the Applicants' patent agent's opinion into consideration when reviewing the response to the Office Action. Applicants have amended claim 1 to incorporate the limitations of claim 6 in this response.

3. Claim Rejections 35 U.S.C. § 112

Claim 9 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. The Office Action states that there is insufficient antecedent basis for "the selection" limitation in claim 9. Applicants have amended claim 9 to depend upon claim 8 instead of claim 1, thus providing sufficient antecedent basis for "the selection" limitation in claim 9.

4. Claim Rejections 35 U.S.C. § 102

Claims 1, 5, 6, 11, 12, 14, 17, 19, 20, 22, 24, and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,490,680 to Scheidt et al. (hereinafter "Scheidt"). Applicants respectfully traverse

these rejections. The original independent claims claimed
a method, computer system, and computer program product for
securely transmitting data in a network with limitations
comprising:

>establishing a secure connection
>between a plurality of computers and
>transmitting a password across the
>secure connection, the password used to
>encrypt and decipher data; and

>transmitting data encrypted using the
>password over a non-secure connection.

Applicants have amended the independent claims to
include the limitations of "*sending a request from a first
computer to a second computer prior to establishing a
secure connection, the first computer and the second
computer included in a plurality of computers; and
receiving a response from the second computer, whereby the
response informs the first computer that the second
computer accepts encrypted data,*" which was claimed by
Applicants in original claims 6, 14, and 22.

In rejecting claim 6, the Office Action asserts that
Scheidt teaches using a secured channel to send the
password to the second computer and thus, "*it is inherent
that Scheidt must have means to send a request and have
acknowledgement responding to the request … and further
informing . the first computer system that the second
computer system accepts encrypted data.*" Applicants
respectfully disagree. While Applicants find no fault with
the Examiner's observation that Scheidt teaches using a
secured channel to send the password to the second
computer, Applicants disagree with the Office Action's
conclusion that the claimed features of receiving a

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response from the second computer informing the first computer that it accepts data that is encrypted are inherently disclosed by Scheidt as a result. MPEP 2112 states:

> "The fact that a certain result or characteristic **may** occur or be present in the prior art is **not** sufficient to establish the inherency of that result or characteristic...To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." (emphasis added)

The Office Action's inherency assertion is unfounded. While it may be inherent in Scheidt for computers to send requests and responses corresponding to the establishment of a <u>secure connection</u>, it is not inherent that the two computers send requests and responses corresponding to one of the computer's ability to <u>accept split keys</u>. In fact, Scheidt teaches away from this assertion.

Scheidt teaches a closed system for split key distribution between a policy manager and a credential manager. Scheidt states that

> Constructive key management integrates organizational information flow and control with an encryption key creation, distribution, combination, and authentication process...These split keys are created by a Policy Manager for overall organizational distribution and

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>   managed through a credential manager to
>   the user." (col. 4: 29-36, emphasis
>   added)

The policy manager comprehends that the credential manager accepts encrypted split keys, so there is no need for the policy manager to send a request to the credential manager. In addition, by adding another step of sending a request and receiving a response as suggested by the Office Action directly contradicts what Scheidt teaches. Scheidt states that "*although the older key management systems of the 80's and 90's worked well for point-to-point communications and one-to-one file transfer, **they are too time consuming** to use in a case wherein a single file is placed on a file server and decrypted by thousands of users.*" (col. 3: 43-49, emphasis added). Adding a step as suggested by the Office Action contradicts the teachings of Scheidt to minimize time, and, therefore, is not inherent.

Thus, since Scheidt neither teaches nor suggests the claimed limitation of "*sending a request from a first computer to a second computer prior to establishing a secure connection, the first computer and the second computer included in a plurality of computers; and receiving a response from the second computer, whereby the response informs the first computer that the second computer accepts encrypted data*", Scheidt fails to anticipate the present invention as recited in amended independent claim 1. Therefore, Applicants have traversed the 102 rejection and Applicants assert that claim 1, as amended, is in condition for allowance.

Claim 11 as amended is a computer system claim with at least the same limitations as amended claim 1 and, therefore, is allowable for at least the same reasons as claim 1. Claim 19 as amended is a computer program product claim with at least the same limitations as amended claim 1 and, therefore, is allowable for at least the same reasons as claim 1. Claim 27 as amended is a method claim including at least the same limitations as amended claim 1 and, therefore, is allowable for at least the same reasons as amended claim 1.

Each of the remaining claims, 5, 6, 12, 14, 17, 20, 22, and 24 each depend, directly or indirectly, on one of the allowable independent claims 1, 11, and 19. Therefore, claims 5, 6, 12, 14, 17, 20, 22, and 24 are also allowable for at least the same reasons that the respective independent claims are allowable.

5. Claim Rejections 35 U.S.C. § 103

A. Scheidt in view of Eberle

Claims 8, 9, 10, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheidt in view of U.S. Patent No. 4,249,180 to Eberle et al. (hereinafter "Eberle"). Applicants respectfully traverse these rejections.

Applicants assert that the Office Action fails to establish a prima facie case of obviousness. MPEP 2142 states that:

> "To establish a prima facie case of obviousness, three basic criteria must be

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> met. *First, there must be some suggestion*
> *or motivation, either in the references*
> *themselves or in the knowledge generally*
> *available to one of ordinary skill in the*
> *art, to modify the reference or to*
> *combine reference teachings. Second,*
> *there must be a reasonable expectation of*
> *success. Finally, the prior art*
> *reference (or references when combined)*
> *must teach or suggest all the claim*
> *limitations. The teaching or suggestion*
> *to make the claimed combination and the*
> *reasonable expectation of success must*
> *both be found in the prior art, and not*
> *based on applicant's disclosure."*

Applicants assert that the Office Action fails to show that the prior art references teach or suggest **all** of Applicants' claim limitations. In particular, Applicants assert that the Office Action fails to view Applicants' invention as a "whole." MPEP 2141 states that *"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole..."* Applicants assert that the Office Action interchanges Scheidt's terminology in view of Eberle to reject particular elements of Applicants' claims without applying Scheidt's terminology in view of Eberle's terminology to Applicants' claims as a whole. MPEP 2143.03 states:

> *"To establish prima facie obviousness of a*
> *claimed invention, all the claim limitations*
> *must be taught or suggested by the prior*
> *art.*_All words_ *in a claim must be considered*
> *in judging the patentability of that claim*
> *against the prior art"* (emphasis added)

In addition, MPEP 2106 states:

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> "…when evaluating the scope of a claim,
> every limitation in the claim must be
> considered.   Office personnel _may not_
> _dissect_ a claimed invention into discrete
> elements and then evaluate the elements in
> isolation." (emphasis added)

Applicants assert that the Office Action fails to consider _all words_ in Applicants' claims as a whole during their patentability judgment and that the Office Action dissects the limitations of claim 1 with the limitations of dependent claim 8 in order to reject Applicants' claim 8. Specifically, claim 8 further limits claim 1 by claiming the additional limitations of:

wherein the data is selectively encrypted.

Applicants' claimed invention selectively encrypts the data that is transmitted over a non-secure channel. The Office Action interchanges Scheidt's term "split keys" with Eberle's term "data" in order to reject Applicants' claim 8. In doing this, the Office Action does not consider all words in Applicants' claim as discussed above. Eberle does teach selectively encrypting data. However, using the reasoning of the Office Action's suggested combination of Scheidt with Eberle, the combination results in "selectively encrypting split keys." Since Scheidt teaches encrypting _all_ split keys when they are sent over a non-secure network, the combination of Scheidt with Eberle contradicts the teachings of Scheidt. Therefore, since neither Scheidt nor Eberle teach or suggest, alone or in combination with one another "wherein the data is

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selectively encrypted" in combination with the limitations included in amended claim 1, dependent claim 8 is allowable under 35 U.S.C. § 103 over Scheidt in view of Eberle.

Notwithstanding that fact, that claim 9 is dependent upon claim 8 and is therefore allowable for at least the same reasons as claim 8, claim 9 is also allowable as this claim is not obvious in light of Scheidt in view of Eberle. Claim 9 further limits claim 8 by claiming the additional limitations of:

> wherein the selection is based on determining a sensitivity corresponding to the data.

Applicants' claimed invention selectively encrypts the data based upon the sensitivity of the data. Using the reasoning of the Office Action's suggested combination of Scheidt with Eberle, the combination results in *"selectively encrypting split keys based upon the split keys' sensitivity level."* As discussed above, selectively encrypting split keys contradicts the teachings of Scheidt. In addition, Scheidt teaches that each split key has the same sensitivity level and, therefore, selectively encrypting Scheidt's split keys based upon their sensitivity also contradicts the teachings of Scheidt. Therefore, since neither Scheidt nor Eberle teach or suggest, alone or in combination with one another, *"wherein the selection is based on determining a sensitivity corresponding to the data"* in combination with the limitations included in claim 8 and amended claim 9, claim

9 is allowable under 35 U.S.C. § 103 over Scheidt in view of Eberle.

Notwithstanding that fact, that claim 10 is dependent upon claim 1 and is therefore allowable for at least the same reasons as claim 1, claim 10 is also allowable as this claim is not obvious in light of Scheidt in view of Eberle. Claim 10 further limits claim 1 by claiming the additional limitations of:

> analyzing the data packet and
> determining whether the data packet is
> encrypted; and
>
> selectively deciphering the data packet
> based on the analyzing.

Using the reasoning of the Office Action's suggested combination of Scheidt with Eberle, the combination results in *"selectively deciphering split keys based upon whether the split keys are encrypted when they are sent over a non-secure network."* As discussed above, Scheidt teaches encrypting all split keys when they are sent over a non-secure network. Therefore, selectively deciphering the split keys contradicts the teachings of Scheidt. Therefore, since neither Scheidt nor Eberle teach or suggest, alone or in combination with one another, *"analyzing the data packet and determining whether the data packet is encrypted, and selectively deciphering the data packet based on the analyzing,"* claim 10 is allowable under 35 U.S.C. § 103 over Scheidt in view of Eberle.

B. Scheidt in view of Ehrsam

Claims 2, 3, 13, 15, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheidt in view of U.S. Patent No. 4,238,853 to Ehrsam et al (hereinafter "Ehrsam"). Applicants respectfully traverse these rejections.

Claims 2 and 3 each depend, either directly or indirectly, upon amended claim 1. Therefore, claims 2 and 3 are allowable for at least the same reasons as amended claim 1 as stated above. Claims 13 and 15 each depend, either directly or indirectly, upon amended claim 11. Therefore, claims 13 and 15 are allowable for at least the same reasons as amended claim 11 as stated above. Claim 21 depends upon amended claim 19 and, therefore, is allowable for at least the same reasons as amended claim 19 as stated above.

C. Scheidt in view of Tachnibana

Claims 4, 7, 16, 18, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scheidt in view of Japanese Patent No. JP363039228 to Tachnibana, Noriyuki (hereinafter "Tachnibana"). Applicants respectfully traverse these rejections.

Claims 4 and 7 each depend, either directly or indirectly, upon amended claim 1. Therefore, claims 4 and 7 are allowable for at least the same reasons as amended claim 1 as stated above. Claims 16 and 18 each depend,

either directly or indirectly, upon amended claim 11.
Therefore, claims 16 and 18 are allowable for at least the
same reasons as amended claim 11 as stated above. Claim 23
depends upon amended claim 19 and, therefore, is allowable
for at least the same reasons as amended claim 19 as stated
above.

CONCLUSION

As a result of the foregoing, it is asserted by
Applicants that the amended claims in the Application are
in condition for allowance, and Applicants respectfully
request an early allowance of such claims.

Applicants respectfully request that the Examiner
contact the Applicants' attorney listed below if the
Examiner believes that such a discussion would be helpful
in resolving any remaining questions or issues related to
this Application.

                            Respectfully submitted,
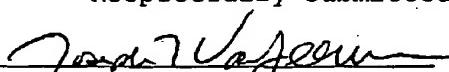
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